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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/391,869 09/08/99 SMITH

M 83317/00004

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QM22/0226

EXAMINER

JOHN E THOMAS
HARTER SECREST & EMERY LLP
700 MIDTOWN TOWER
ROCHESTER NY 14604

THURSTON, A

ART UNIT	PAPER NUMBER
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3722

DATE MAILED:

02/26/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/391,869

Applicant(s)

SMITH, MARY

Examiner

Alisa Thurston

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6-9, 11, 12, 19, 22, 26-28 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedman US Patent No. 5,042,841.

Friedman discloses the claimed invention including a method of binding a book and a book with a front cover and back cover and in between having pages and a pocket insert comprising a base sheet (14), with a binding edge (32) bound to the binding, and a pocket sheet (12) with a smaller width, but at least 60 percent of the base sheet and the perimeter of which is defined by an attached edge (18) to the base sheet and a free section (24) to form a pocket opening extending substantially parallel and facing the binding (see figure 2). Friedman also discloses the base sheet comprising a first edge (50), a second edge (18) opposed to the first edge and defining the binding edge and third and fourth edges (F3) opposed to one another and disposed between the first and second edges and defining the length of the base sheet and the pocket sheet with a first edge (F1) attached to the base sheet and a second edge opposed to the first edge and defining the width of the pocket sheet and a position of it attached to the base sheet (see figure 1) to form the pocket opening and third and fourth edges defining the length of the pocket sheet which has a shorter

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length than the base sheet and where the base sheet and the pocket sheet are formed of a single section of paper material.

In reference to claim 32, Friedman also discloses a pocket insert comprising a base sheet (14) with a binding edge (18) and a pocket insert (12) having a perimeter defined by an attached edge (50) to the base sheet and a free edge (see figure 3) unattached to the base sheet to form a pocket with the opening along the free edge section and facing the binding (see figure 2) and the pocket insert having a thickness less than the combined thickness of the base sheet and the pocket sheet (see figure 3).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 10, 13-18, 20, 21, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman US Patent No. 5,042,841 in view of Lippeth et al US Patent No. 6,024,508. Friedman discloses the claimed invention as set forth in the above rejection in addition to attaching the base sheet to the pocket sheet with adhesive along the third and fourth edges.

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However, Friedman does not disclose the base sheet and the pocket sheet formed of separate sheets of paper material adhered to one another along the attached edge section, and along another long strip parallel to the third and fourth edges to separate the pockets to form two sheets, the base sheet formed of a length of about 11 inches and a width of 5 to 6 inches, and the multiple pages being 11 x 8.5 inches, and supplemental media retained in the pockets.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the base sheet and the pocket sheet formed of separate sheets of paper material adhered to one another along the attached edge section, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Furthermore, the use of adhesive to attach two sheets together is widely known in the art. Therefore, it would have been obvious to attach the base sheet to the pocket sheet with adhesive along the edges in order to provide a bond between them to form a pocket.

It would have been an obvious matter of design choice to form the base sheet of a length of about 11 inches and a width of 5 to 6 inches, and the multiple pages being 11 x 8.5 inches, since such a modification would have involved a mere change in the size of a component, if necessary. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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The use of long strips parallel to edges in a pocket is widely known in the art for dividing a pocket into multiple pockets. One such example is Lippeth, who discloses the use of a long strip parallel to third and fourth edges in order to create multiple pockets. Lippeth also discloses the use of these pockets for supplemental media (column 4, lines 1-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use of a long strip parallel to third and fourth edges in order to create an additional pockets and to put supplemental media in these pockets, as widely known in the art and shown by Lippeth, in order to provide easy carrying means for multiple articles. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed (i.e. to carry supplemental media) does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Response to Arguments

5. Applicant's arguments filed 12/1/00 have been fully considered but they are not persuasive.

The applicant argues that the pocket sheet of Friedman is not attached to the base sheet. The examiner disagrees. The pocket sheet and the base sheet of Friedman are attached to each other at three separate sides. Edge (18) is attached since Friedman suggest making both sheets of

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a single piece of material, making this edge between the sheets an integral edge. Edges 16 and 20, comprise the side edges that form the pocket sheet. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the edges integral or separate, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., thickness less than three layers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXING of responses to Office Actions directly into the Group at (703) 305-3579.

Transmissions can be received from the Applicant at all times. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. The faxing of such documents must conform with the notice published in the official Gazette, 1096 OG 30 (October 19, 1998).


Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3720 will be promptly forwarded to the Examiner. Applicant is reminded to clearly mark any transmissions as "DRAFT" if it is not to be considered as an official response.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alisa Thurston whose telephone number is (703) 305-1645. The examiner can normally be reached on Monday-Friday from 7:00 am to 4:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, A. L. Wellington, can be reached on (703) 308-2159.

Any inquire of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

ALT

February 22, 2001


A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
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